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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JARRETT, RYAN A

ART UNIT

PAPER NUMBER

2121

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,733	Applicant(s) HAWMAN ET AL.	
	Examiner Ryan A. Jarrett	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/25/08,03/13/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/13/08,03/13/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 17-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/05/06.

Information Disclosure Statement

The information disclosure statements filed 03/13/08 fail to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). They have been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statements filed 03/13/08 fail to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). They have been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

The indicated allowability of former claims 23-26 is withdrawn in view of the newly discovered reference(s) to DeBrouse, and in view of the newly discovered case law *In re Ngai* and *In re Gullack*. Rejections based on the newly cited reference(s) follow and case law follow.

Claim Objections

Claims 24-27 are objected to because they depend from a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by the gas turbine engine part of Marshall et al. US 6,728,610 (e.g., col. 1 lines 9-11), or under 35 U.S.C. 102(b) as being anticipated by the gas turbine engine part of Martin US 4,280,185 (e.g., Fig. 1 #18), since:

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, ³⁶⁷ F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the

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instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Even if the printed matter on Applicant's claimed tag were to receive patentable weight, the claims are still considered obvious as detailed below.

Claims 22 and 24-27 are additionally rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. US 6,728,610 in view of DeBrouse US 5,920,053.

Marshall et al. discloses:

22. A gas turbine engine part (e.g., col. 1 lines 9-11), comprising:

a paper tag comprising at least one part identifier information affixed to a gas turbine engine part having undergone a maintenance operation, wherein said tag corresponds to an electronic record and is a substitute for a plurality of paperwork pertaining to said maintenance operation (e.g., col. 1 lines 60-65: "In one embodiment, the 'as flying' configuration can be determined, at least in part, by querying bar codes associated with one or more engine components. Alternatively, or in combination with the use of such bar codes, the 'as flying' configuration can be determined by querying microchips associated with one or more engine components", col. 3 lines 13-29: "Alternatively, or in combination, programmable devices capable of storing, receiving, and/or sending data can be associated with one or more engine components. In one embodiment, microchips can be associated with the

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components, and can be queried by the maintenance system. For example, microchips known as ‘smart tags’ can be attached to or otherwise associated with the components.”),

wherein said at least one part identifier information comprises a part information section (e.g., col. 2 lines 1-3: “a processor which is coupled, such as electronically, to an aircraft engine and programmed with a unique identifier corresponding to the aircraft engine”), **a customer information section, a status section** (e.g., col. 1 lines 60-65: “as flying configuration”, col. 3 lines 13-29: “repair status”), **a bar code section** (e.g., col. 1 lines 60-65: “bar codes”) **and a routing information section.**

24. The gas turbine engine part of claim 22, wherein said status section comprises a disposition of said part according to said electronic record (e.g., col. 1 lines 60-65: “as flying configuration”, col. 3 lines 13-29: “repair status”).

25. The gas turbine engine part of claim 22, wherein said bar code section comprises a unique identifier of said part assigned to said electronic record (e.g., col. 1 lines 60-65, col. 3 lines 13-29, col. 4 lines 19-21).

26. The gas turbine engine part of claim 22, wherein said routing information section comprises a maintenance operation history of said part through a maintenance facility (e.g., col. 1 lines 30-31, col. 5 lines 5-41).

27. The gas turbine engine part of claim 22, wherein said maintenance operation is a maintenance, repair or overhaul of said part (e.g., col. 3 lines 13-29, *The type of “operation” undergone by the claimed “gas turbine engine part” does not limit the structure of the gas turbine engine part or the tag.*).

Per claim 1, Marshall et al. does not explicitly disclose that the bar code tag is a paper tag, further comprising a customer information section and a routing section (claim 1). Marshall et al. is silent as to the specifics of the bar code “tag” and how it is implemented, i.e., whether or not it is a paper tag.

Per claim 26, although Marshall et al. does disclose routing information comprising a maintenance operation history of said part through a maintenance facility (e.g., col. 1 lines 30-31, col. 5 lines 5-41), Marshall et al. does not explicitly disclose that said tag comprises said routing information.

However, it is well known in the art for bar codes to be implemented on paper tags. And it is well known in the art to use paper tags to label and track items. And it is well known in the art to include customer information and routing information on such tags.

For example, DeBrouse discloses an item comprising a paper tag comprising at least one part identifier information affixed to the item, wherein the at least one part identifier information comprises a part information section (e.g., Fig. 5 #112, col. 6 line 13: “Baggage Identification Bar Code 112”), a customer information section (e.g., Fig. 5: “AIRLINE”, “PASSENGER NAME”), a status section (e.g., Fig. 5: “AIRPORT”, “DATE”, “# OF CHECKED BAGS”, “# OF CARRY-ON BAGS”), a bar code section (e.g., Fig. 5 #112,122) and a routing section (e.g., Fig. 5: “FLIGHT# DESTINATION”, col. 6 lines 17-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Marshall et al. with DeBrouse since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by

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known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

It further would have been further obvious sine the substitution of one known element (bar code tag or electronic tag) for another (paper tag) would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/
Primary Examiner, Art Unit 2121

04/27/08